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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/767,224  | 01/27/2004  | Alan Phillips        | 0275L-001494/US     | 2591             |
| 76237   | 7590        | 10/06/2008           |                     |                  |
| Harness Dickey & Pierce, P.L.C.<br>P.O. Box 828<br>Bloomfield Hills, MI 48303 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| FREAY, CHARLES GRANT  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 3746  |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/767,224

**Applicant(s)**

PHILLIPS, ALAN

**Examiner**

Charles G. Freay

**Art Unit**

3746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 15-28, 30-40, 42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-28, 30-40, 42 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 7, 2008 has been entered.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the isolating valve structure of claims 10 and 25 and the docking station cover of claims 15, 30 and 42 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The material relating to the tank being constructed to be isolated has not been sufficiently described or set forth in the disclosure. Paragraph [0025] discusses using a valve to isolate a tank but does not discuss the particular arrangement of the valve to the rest of the apparatus. The claims set forth that the tank is constructed to be pneumatically isolated. It is unclear what the relationship of the valve is to the tank or if

the valve is supposed to be and integral and operating part of the tank. The disclosure has not provided an enabling disclosure of the required valve and tank structure.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-9, 11-13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vitaloni (USPN 4,331,883) in view of Eggert (USPN 6,562,509).

Vitaloni discloses an air compressor (Abstract and Fig. 8) including an electric motor (76) and an electrical system including a rectifier74, a switch (94, col. 4 lines 39 and 40) for selecting the power source to be a electric power cable (80) connected to 110 V 60 Hz supply or connection to a battery (col. 4 lines 27-29). Col. 4 lines 5-18 make clear that the electric control circuit and the transformer operate as a voltage

regulator. In Vitaloni the compressor unit is hand carried. Vitaloni do not disclose that the battery includes a docking station and a rechargeable battery. Eggert discloses that it is well known to provide rechargeable batteries with a docking station for hand operated and remotely used devices. At the time of the invention it would have been obvious to one of ordinary skill in the art to substitute a rechargeable battery and docking station as taught by Eggert for the generically disclosed battery of Vitaloni in order to provide a battery which is renewable. Thus allowing for greater flexibility of use and reducing the operating cost of the system.

With regards to claim 3 the battery of Eggert is clearly capable of use with other tools. With regards claims 6 and 7 motor of Vitaloni is set forth as a 12V or 24V motor thus it would have been obvious to provide a battery of corresponding voltage. Furthermore, it would have been obvious to provide a correctly sized motor and battery in dependence upon a particular application. Lastly, with regards to claim 12 the claim merely sets forth a desired pressure which is not structurally limiting and which would be obvious in dependence upon the desired application.

With regards to claim 9 the examiner notes that the applicant did not challenge the previous taking of official notice which represents an admission that the connection of plural batteries in parallel is well known. Additionally, the use of plural docking stations is a mere duplication of parts.

With regards to claim 15 the examiner gives official notice that covers are well known and that it would have been obvious to one of ordinary skill in the art to provide a cover for added protection.

Claims 1-9, 11, 12, 15-24, 26, 27, 30-38, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al (USPAP 2003/0059320) in view of Leighton et al (USPN 6,676,382) and Eggert (USPN 6,562,509).

Kim et al discloses an air compressor (121 and Fig. 17) including an electric motor (101) and an electrical system including a switch (note [0051]) for selecting the power source to be a electric power cable (105) or connection to a battery. Kim et al discloses that the compressor delivers air to a tank (130). Kim et al do not disclose that the battery includes a docking station and a rechargeable battery or that there is a rectifier and voltage regulator and the switch automatically causing the motor to operate from a battery coupled to the docking station if no electricity is applied. As set forth in the previous office action Leighton discloses a electric power supply having a switch which automatically uses a battery if no electricity is supplied and a rectifier and a voltage regulator. Eggert discloses that it is well known to provide rechargeable batteries with a docking station for hand operated and remotely used devices. At the time of the invention it would have been obvious to one of ordinary skill in the art to substitute a electric circuit as taught by Leighton for the generic circuit of Kim et al as a well know selection circuit which will continuously supply power and to utilize a rechargeable battery and docking station as taught by Eggert for the generically disclosed battery of Kim et al in order to provide a battery which is renewable. Thus allowing for greater flexibility of use and reducing the operating cost of the system.

With regards to claim 3, 18 and 32 the battery of Eggert is clearly capable of use with other tools. With regards claims 6, 7, 21, 22, 35 and 36 the examiner gives official notice that batteries having a voltage 12 to 24 Volts are well known. Furthermore, it would have been obvious to provide a correctly sized motor and battery in dependence upon a particular application. Lastly, with regards to claims 12 and 27 the claims merely



sets forth a desired pressure which is not structurally limiting and which would be obvious in dependence upon the desired application.

With regards to claims 9, 24 and 38 the examiner notes that the applicant did not challenge the previous taking of official notice which represents an admission that the connection of plural batteries in parallel is well known. Additionally, the use of plural docking stations is a mere duplication of parts.

With regards to claims 15, 32 and 42 the examiner gives official notice that covers are well known and that it would have been obvious to one of ordinary skill in the art to provide a cover for added protection.

Claims 10, 13, 25, 28 and 40, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al in view of Leighton et al and Eggert as applied to claims 1 and 17 above, and further in view of Cherry et al (USPN 6,991,437).

Kim et al in view of Leighton et al and Eggert set forth the invention substantially as claimed as set forth above. Kim et al in view of Leighton et al and Eggert do not set forth that there are two tanks or that the compressor can be hand carried. Cherry discloses an air compressor system having two tanks (124) which can be hand carried (see 150). At the time of the invention it would have been obvious to one of ordinary skill in the art to utilize two tanks in order to provide the correct capacity for the device which will be driven by the compressed air and also to make the device hand portable for ease of use.

Claims 2, 17-24, 26-28, 30-40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vitaloni in view of Eggert as applied to claim 1 above, and further in view of Leighton.

Vitaloni in view of Eggert discloses the invention substantially as claimed as set forth above. Vitaloni do not disclose that the switch automatically causes the motor to operate from a battery coupled to the docking station if no electricity is applied. As set forth in the previous office action Leighton discloses an electric power supply having a switch which automatically uses a battery if no electricity is supplied. At the time of the invention it would have been obvious to one of ordinary skill in the art to substitute a electric circuit as taught by Leighton for the generic circuit of Vitaloni as a well know selection circuit which will continuously supply power.

With regards to claim 18 and 32 the battery of Eggert is clearly capable of use with other tools. With regards claims 21, 22, 35 and 36 the examiner gives official notice

that batteries having a voltage 12 to 24 Volts are well known. Furthermore, it would have been obvious to provide a correctly sized motor and battery in dependence upon a particular application. Lastly, with regards to claim 27 the claim merely sets forth a desired pressure which is not structurally limiting and which would be obvious in dependence upon the desired application.

With regards to claims 24 and 38 the examiner notes that the applicant did not challenge the previous taking of official notice which represents an admission that the connection of plural batteries in parallel is well known. Additionally, the use of plural docking stations is a mere duplication of parts.

With regards to claims 32 and 42 the examiner gives official notice that covers are well known and that it would have been obvious to one of ordinary skill in the art to provide a cover for added protection.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cronin and Molina et al disclose battery operated compressor systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles G. Freay whose telephone number is 571-272-4827. The examiner can normally be reached on Monday through Friday 8:30 A.M. to 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Devon Kramer can be reached on 571-272-7118. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles G Freay/  
Primary Examiner  
Art Unit 3746

CGF  
September 30, 2008